

REMARKS

Applicant has carefully studied the Final Office Action of February 23, 2005. In response thereto, Applicant amends some of the claims and files a Request for Continued Examination.

Claims 1, 9, 10, 15, 17, 18, 25, 26, 27, 31, 45, 47, 48, 49, and 50 are amended to make the claim terminology consistent. No new matter is added.

Applicant also amends claims 1, 16, 24, 26, 35, 42, and 47 to indicate that the communications function occurs outside the virtual reality embodiment. Support for this can be found in at least Figures 2A and 2B of the application as originally filed. A specific example of the communications function outside the virtual reality environment is the connection between the communication devices 40B and 50B outside the virtual reality system 20 of Figure 2A. No new matter is added.

In contrast, the communication function of McNerney et al. occurs within the context of the virtual reality environment. For example, the white board, the video tape player, and the like all exist within the virtual reality environment (see McNerney et al. at col. 2, lines 35-38, 39-57, and 62-64 and col. 6, lines 39-55). Thus, McNerney et al. does not show the amended element.

Applicant now addresses the specific rejections set forth in the Office Action.

Claims 1-9, 15-18, 22-24, 42-49, and 51 were rejected under 35 U.S.C. § 102(e) as being anticipated by McNerney et al. (hereinafter "McNerney"). Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where each and every claim element is located. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

As amended, claims 1, 16, 24, 42, and 47 recite that the communications function occurs outside the virtual reality environment. As noted above, McNerney does not teach or suggest the communication function occurring outside the virtual reality environment. In fact, McNerney teaches the opposite because McNerney teaches that the white board, tape player, and other communication functions occur inside the virtual reality environment. Applicant has provided specific citations above. The example in col. 6 of McNerney is typical, wherein the participant points to the file drawer 603 and clicks the mouse to indicate a selection. The graphical user interface 601 (part of the virtual meeting services circuit 28) then presents this information to the conference participants within the virtual reality environment. To this extent,

McNerney not only does not teach the recited claim element, but also teaches away from the recited claim element. Since McNerney does not teach the recited claim element, McNerney does not anticipate the amended claims. Applicant requests withdrawal of the § 102 rejection of claims 1, 16, 24, 42, and 47 at this time.

Claims 2-9 and 15 depend from claim 1, and are not anticipated at least for the same reasons. Claims 17, 18, 22, and 23 depend from claim 16, and are not anticipated at least for the same reasons. Claims 43-46 depend from claim 42, and are not anticipated at least for the same reasons. Claims 48, 49, and 51 depend from claim 47, and are not anticipated at least for the same reasons.

Claims 10-14, 19-21, 25, 50, 52, and 53 were rejected under 35 U.S.C. § 103 as being unpatentable over McNerney in view of Swartz. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness determination, the Patent Office must do two things. First, the Patent Office must set forth a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, to establish *prima facie* obviousness, the Patent Office must still show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine McNerney and Swartz. Specifically, the Patent Office opines that the motivation to combine McNerney and Swartz is “for screening and rerouting calls from designated numbers.” This asserted motivation lacks any evidence in support thereof. Since the motivation is not properly supported, the motivation is improper. Since the motivation is improper, the combination is improper. Since the references individually do not establish obviousness, and the combination of references is improper, the rejection is improper. Applicant requests withdrawal of the rejection on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not teach or suggest that the communication function occurs outside the virtual reality environment. As noted above, McNerney teaches the opposite of the claimed invention and the Patent Office has not identified where in Swartz the element is taught or suggested. Since the references individually do not teach or suggest the claim element (and in fact teach away from the claim element), the combination of references does not teach or suggest the claim

element. Since the combination does not teach or suggest the claim element, the combination does not establish *prima facie* obviousness. Applicant requests withdrawal of the § 103 rejection of the claims at this time.

Claims 26-30, 35, and 39-41 were rejected under 35 U.S.C. § 103 as being unpatentable over McNerney in view of Krishnaswamy et al. (hereinafter "Krishnaswamy"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

Applicant initially traverses the motivation to combine as improper. Specifically, the Patent Office asserts that the motivation to combine McNerney and Krishnaswamy is "to transmit video audio and data communication of designated quality over the internet to other registered video telephony users." This asserted motivation lacks any evidence in support thereof. Since the motivation is not properly supported, the motivation is improper. Since the motivation is improper, the combination is improper. Since the references individually do not establish obviousness, and the combination of references is improper, the rejection is improper. Applicant requests withdrawal of the rejection on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not teach or suggest that the communication function occurs outside the virtual reality environment. As noted above, McNerney teaches the opposite of the claimed invention, and the Patent Office has not identified where in Krishnaswamy the claim element is taught or suggested. Since the references individually do not teach or suggest the claim element (and in fact teach away from the claim element), the combination of references does not teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish *prima facie* obviousness. Applicant requests withdrawal of the § 103 rejection of the claims at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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